

**REMARKS**

Claims 1, 3-11, and 13-20 are pending in this application.

Applicants have amended claims 1 and 11, and have canceled claims 2 and 12. These changes do not introduce any new matter.

**Rejections under 35 U.S.C. § 103**

Applicants respectfully request reconsideration of the rejection of claims 1, 3-7, 10, 11, 13-17, and 20 under 35 U.S.C. § 103(a) as being unpatentable over *Nakami et al.* (“*Nakami ‘667*”) (US 2003/0151667 A1) in combination with *Nakami ‘127* (US 2003/0035127 A1). As will be explained in more detail below, the combination of *Nakami ‘667* and *Nakami ‘127* would not have rendered the subject matter defined in independent claims 1 and 11, as amended herein, obvious to one having ordinary skill in the art.

Applicants have amended independent claims 1 and 11 to include the features specified in original claims 2 and 12, respectively. As defined in amended claims 1 and 11, the claimed subject includes, *in the course of selecting a template used for printing*, setting either execution of non-execution of shooting information-based printing, which represents printing with shooting information set at a time of shooting an image.

As recognized by the Examiner, neither the *Nakami ‘667* reference nor the *Nakami ‘127* reference discloses or suggests a shooting information-based print setting module as specified in amended claim 1 or a corresponding method operation as specified in claim 11. In the Office Action, the Examiner rejected claims 2 and 12 under 35 U.S.C. § 103(a) as being unpatentable over *Nakami ‘667* and *Nakami ‘127* as applied against claims 1 and 11, and further in view of *Acker et al.* (“*Acker*”) (US 6,883,140 B1). To the extent that the obviousness rejection of claims 2 and 12 might be considered applicable to amended claims 1 and 11, Applicants respond as follows.

The *Acker* reference discloses a system and method for editing digitally represented still images. In support of the obviousness rejection, the Examiner asserts that the *Acker* reference discloses the features of original claims 2 and 12, which have been incorporated into claims 1 and 11, respectively. Applicants respectfully traverse the Examiner's characterization of the *Acker* reference relative to the claimed subject matter. The *Acker* reference includes a description concerning enabling the user to select a particular template, for example, a template which enables the user to organize two or four pictures per page when executing the print operation. This description, however, does not constitute either a disclosure or a suggestion of a shooting information-based print setting module (or the corresponding method operation) as specified in the presently claimed subject matter. As defined in present claim 1, the shooting information-based print setting module sets, in the course of selecting a template used for printing, either execution or non-execution of shooting information-based printing. In contrast, the *Acker* reference merely discloses a series of templates that can be used to organize images for printing.

Further, with regard to the editing execution module specified in present claim 1 (and the corresponding method operation specified in present claim 11), the Examiner acknowledges that this feature is not shown in the *Nakami* '667 reference, but asserts that it is shown in the *Nakami* '127 reference. Applicants respectfully traverse the Examiner's characterization of the *Nakami* '127 reference relative to the claimed subject matter. The *Nakami* '127 reference describes the manual setting of parameter values to change parameter values selected by the correction mode, or to set a certain parameter value for a desired parameter when a correction mode is not used. See Paragraph [0067]. As specified in present claim 1, the editing execution module restricts editing of the predetermined editing item in the case in which execution of shooting information-based printing is set. In contrast, in the *Nakami* '127 reference, the parameter values set by a correction mode optimized for

each set of photo conditions can be changed as desired. As such, the *Nakami* '127 reference does not disclose or suggest an editing execution module as specified in present claim 1 (or the corresponding method operation specified in present claim 11).

It is axiomatic that the prior art must disclose or suggest each and every feature of the claimed subject matter to establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a). For at least the reasons set forth above, even if the *Nakami* '667, *Nakami* '127, and *Acker* references were to be combined in the manner proposed by the Examiner, the subject matter defined in present claims 1 and 11 would not have resulted. Thus, the combination of the *Nakami* '667, *Nakami* '127, and *Acker* references would not have rendered the subject matter defined in present claims 1 and 11 obvious to one having ordinary skill in the art.

Accordingly, for at least the foregoing reasons, independent claims 1 and 11, as amended herein, are patentable under 35 U.S.C. § 103(a) over the combination of the *Nakami* '667, *Nakami* '127, and *Acker* references. Claims 3-7 and 10, each of which ultimately depends from claim 1, and claims 13-17 and 20, each of which ultimately depends from claim 11, are likewise patentable under 35 U.S.C. § 103(a) over the combination of the *Nakami* '667, *Nakami* '127, and *Acker* references for at least the same reasons set forth above regarding the applicable independent claim.

#### Dependent Claims

Each of dependent claims 8, 9, 18, and 19 ultimately depends from either claim 1 or claim 11. In the Office Action, each of the above-listed dependent claims was rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of *Nakami* '667 in view of *Nakami* '127, and further in view of *Hui et al.* (US 6,237,010 B1). The *Hui et al.* reference does not cure the above-discussed deficiencies of the combination of the *Nakami* '667, *Nakami* '127, and *Acker* references relative to the subject matter defined in present claims 1 and 11. Accordingly, claims 8, 9, 18, and 19 are patentable under 35 U.S.C. § 103(a) over the

combination of the *Nakami* '667, *Nakami* '127, and *Acker* references, and further in view of the *Hui et al.* reference for at least the reason that each of these claims depends from either claim 1 or claim 11.

Conclusion

In view of the foregoing, Applicants respectfully request reconsideration and reexamination of claims 1, 3-11, and 13-20, as presented herein, and submit that these claims are in condition for allowance. Accordingly, a notice of allowance is respectfully requested. In the event a telephone conversation would expedite the prosecution of this application, the Examiner may reach the undersigned at **(408) 749-6902**. If any additional fees are due in connection with the filing of this paper, then the Commissioner is authorized to charge such fees to Deposit Account No. 50-0805 (Order No. ITECP009).

Respectfully submitted,  
MARTINE PENILLA & GENCARELLA, L.L.P.

/Peter B. Martine/

Peter B. Martine  
Reg. No. 32,043

710 Lakeway Drive, Suite 200  
Sunnyvale, California 94085  
**Customer Number 25920**